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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,260	07/24/2003	Robert Greenberg	S202-USA	7590

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EXAMINER

BLATT, ERIC D

ART UNIT	PAPER NUMBER
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3734

NOTIFICATION DATE	DELIVERY MODE
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08/28/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/627,260	Applicant(s) GREENBERG ET AL.	
	Examiner Eric Blatt	Art Unit 3734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Claim 5 recites that the top portion and base portion are curved on surfaces facing outward and flat on surfaces facing each other. In all of the presently submitted drawings, it appears that the top portion and base portion have substantially identical curvatures on both their inner and outer surfaces. Therefore, these elements must be shown or the feature(s) canceled from the claim(s). In response to Applicant's comments in the reply filed May 18, 2009, the only drawings currently of record for Figures 8-11 have been scanned in black and white and show no shading. Corrected drawings should be submitted. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

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of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 5, 6, 8, 11, 20, 21, and 23-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Shippert (US 5,507,807).

Shippert discloses a surgical tool capable of being used for implantation of an electrode array (Figures 3-6) comprising a frontally closed end portion 48 having a curved shape, the curved shape defining a rounded front surface and a back surface opposite the rounded front surface, a base portion 76 coupled to the back surface at a first location, and a top portion 24 coupled to the back surface at a second location. Although the base portion 76 is not formed integrally with or directly joined to the back portion, it is considered to be substantially coupled to the back portion. The distance between the first location and the second location defines an open space capable of receiving and protecting an electrode array. The open space is between the base

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portion and the top portion, and in an operating condition, the base portion is substantially parallel to the top portion. The open space defines a lateral opening of the surgical tool through which an implant may be released. (Figure 6)

Regarding claim 5, the top portion and base portions have portions on their outer surfaces that are curved and portions on their inner surfaces that are substantially flat.

Regarding claim 6, there is a keeper 88 connected to the base portion 76 to limit travel of the top portion 24.

Regarding claim 20, the base portion 76 is concave in one dimension and convex in another while the top portion 24 is convex in two dimensions. (Figure 3)

Regarding claim 24, the electrode array is functionally recited and is not considered to be positively claimed. Shippert discloses a first operating condition (when contact wedge 64 is located proximally as seen in Figure 4) for allowing retention of an electrode array and a second operating condition (when contact wedge 64 is being advanced as seen in Figure 6) for allowing release of an electrode array through the lateral opening. In both operating conditions, the distance between the base portion and the top portion is controlled.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 7, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shippert (US 5,507,807).

Regarding claim 2, as disclosed in Shippert, the tool must be disassembled in order to load an implant 40 between the top and base portions. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide a hinge between the front end portion and the top portion so that an implant could be easily loaded into the delivery chamber without disassembling the device.

Regarding claim 7, Shippert discloses tracks 72a and 72b in the top portion that meet guides 82a and 82b in the base portion to latch the base and top portions together. It would have been obvious provide the tracks on the base portion and the guides on the top portion since such a modification would merely constitute a reversal of parts. The tracks comprise notches.

Regarding claims 9 and 10, it would have been obvious to one of ordinary skill in the art to fashion the tool of Shippert from ABS or stainless steel since it has been held that selecting a material known to be suitable for an intended purpose merely requires ordinary skill in the art.

Claims 4, 12-19, 22, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shippert (US 5,507,807) in view of Hughes (US 6,579,256).

Shippert teaches all elements of claims 4, 12-19, 22, and 26 except for the device being curved to approximate the radius of an eye and that the tool being used to

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deliver an electrode array into an orbital socket. Hughes teaches a similar delivery apparatus wherein the device is curved to approximate the radius of an eye, and teaches using said apparatus for delivery an electrode array into an orbital socket. (Figures 2-12 and Col. 4, Lines 33-37) It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus and method of Shippert by curving the top and base portions to approximate the radius of an eye and using said the tool for delivering an electrode array into an orbital socket in order to restore a degree of vision to a patient as taught by Hughes.

Specifically regarding claim 17, Shippert discloses that the top and base portions slide relative to one another to allow an implant to be placed therebetween. It would have been obvious to one of ordinary skill in the art at the time of the invention to instead hingedly couple the top and base portions together since this would be a functionally equivalent mechanism for allowing access to the chamber between the top and base portions.

Response to Arguments

Applicant's arguments filed May 18, 2009 have been fully considered but they are not persuasive.

Regarding the drawings, the only drawings currently of record are in black and white, and show no shading. The features recited in claim 5 are not shown in the drawings of record.

Regarding the art rejections, Applicant submits that since Shippert never mentions electrodes, the tool cannot be considered to be, "for implantation of an electrode array," and that the open space between the first and second location cannot be considered to be, "suitable to receive and protect an electrode array," as recited in the claims. This language merely requires that the device is capable of performing these functions. Examiner submits that the device of Shippert is capable of doing so.

Applicant further argues that the obviousness rejection over Shippert in view of Hughes is improper because Hughes fails to teach a device having radii to match the radius of the retina when inserted into an eye. Examiner points to Figures 2 and 5 of Hughes clearly showing the tip of the instrument having a radius substantially matching the radius of the retina when inserted into an eye. Regarding Applicant's submission that the Hughes device is "merely sufficiently flexible to follow the curve of the retina when inserted into an eye," Hughes clearly states that the tip of the instrument has a curvature suited to slide under the retina and into the subretinal space, and its flexibility serves to allow the naturally curved tip to straighten out as it is retracted over a straight mandrel. Thus, the tip is preformed to match the curvature of the retina. Additionally, Examiner notes that even if the tip did employ flexibility to match the curvature of the retina, it is not clear how this would support Applicant's position that, "The device a [sic] Hughes does not have radii to match the radius of the retina." In either case, the tip of the Hughes device matches the curvature of the retina.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Blatt whose telephone number is (571)272-9735. The examiner can normally be reached on Monday-Friday, 9:00 AM-6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. B./

Examiner, Art Unit 3734

/Todd E Manahan/

Supervisory Patent Examiner, Art Unit 3734